

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
 )  
John VONEIFF et al. ) Group Art Unit: To Be Assigned  
 )  
Rule 53 (b) Division of Application Number ) Examiner: To Be Assigned  
09/289,181, filed April 9, 1999 )  
 )  
Filed: March 6, 2002 )  
 )  
For: APPARATUS AND METHOD FOR )  
AUTOMATICALLY PRODUCING )  
TISSUE SLIDES )

PRELIMINARY AMENDMENT

Commissioner of Patents  
Washington, D.C. 20231

Sir:

Prior to an examination of the above-captioned Request for Continued Examination application on the merits and in response to the Office Action mailed April 10, 2001, please amend the application as follows:

IN THE CLAIMS:

Please cancel claims 1-10, without prejudice.

REMARKS

Applicants have amended canceled claims 1-10, without prejudice. These claims were prosecuted to allowance in the parent application.

CONCLUSION


Applicants maintains that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicants' representative, either by telephone or in person, would further prosecution of this application, we would welcome the opportunity for such an interview.

Respectfully submitted,

BROBECK, PHLEGER & HARRISON LLP

Dated: March 6, 2002

By:

  
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Registration No. 42,738

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PRELIMINARY AMENDMENT

Commissioner of Patents  
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Sir:

Prior to an examination of the above-captioned Request for Continued Examination application on the merits and in response to the Office Action mailed April 10, 2001, please amend the application as follows:

IN THE CLAIMS:

Please cancel claims 1-10, without prejudice.

REMARKS

Applicants have amended canceled claims 1-10, without prejudice. In Paper No. 6 of the parent application, mailed August 29, 2000, Applicants were required to elect one of the following allegedly patentably distinct groups of claims for prosecution on the merits:

<u>Group</u>	<u>Claims</u>
I, drawn to a slicing method	1-10
II, drawn to an apparatus for applying	11-19
III, drawn to a method for applying	20-26
IV, drawn to an apparatus for producing slides	27-35

In the parent application, Applicants elected Group I, claims 1-10, with traverse, and prosecuted these claims to allowance. Thus, these claims have been canceled, without prejudice. In this divisional application, **Applicants now elect Group IV, claims 27-35, with traverse.**

According to the MPEP, restriction is appropriate only when the groups can be shown to be distinct and there would be a serious burden on the Examiner to examine more than one group of claims. MPEP 803. The Examiner states that the inventions of Groups II and IV are unrelated. In support of this assertion, the Examiner cites MPEP 806.04 and 808.01, in which states that inventions are distinct "if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects." Paper No. 6 at 3. In the Restriction Requirement, the Examiner has not carried this burden, other than making a conclusory statement. Thus, restriction is not proper.

Further, Applicants maintain that there is no burden placed on the Examiner by examining at least Groups II and IV together. These allegedly patentably distinct groups are in the same class (class 83), with potentially overlapping subclasses. Therefore, Applicants respectfully request that the Examiner withdraw the restriction requirement between Groups II and IV, and examine these groups together.

#### CONCLUSION

Applicants maintains that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicants' representative, either by telephone or in person, would further prosecution of this application, we would welcome the opportunity for such an interview.

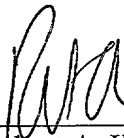
No fee is believed necessary for consideration of the above. However, in the event any such fee is necessary, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-1640.

Respectfully submitted,

BROBECK, PHLEGER & HARRISON LLP

Dated: March 6, 2002

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